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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,572

06/15/2005

Nicolaas Willem Schellingerhout

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

SU, SARAH

ART UNIT

PAPER NUMBER

2131

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,572	Applicant(s) SCHELLINGERHOUT ET AL.	
	Examiner Sarah Su	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/15/05, 11/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-8 are presented for examination

Priority

2. The claim for priority from PCT/IB03/05205 filed on 14 November 2003 is duly noted.
3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.
5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.

- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

6. The disclosure is objected to because of the following informalities:
- a. In page 1, line 16: "forms; information" should read –forms: information–;
 - b. In page 2, line 20: "stored, which unlimited" should read –stored, where unlimited–;
 - c. In page 6, line 18: "could be effected" should read –could be affected–;
 - d. In page 7, line 7: "static, the conversion" should read –static. The conversion–;
 - e. in page 7, line 25: "will effect 16" should read –will affect 16–.
- Appropriate correction is required.

Claim Objections

7. Claims 2-4, 6-8 are objected to because of the following informalities:
- a. In claims 2-4, line 1: "digital content" is unclear if it relates to "digital content (claim 1, line 3);
 - b. In claim 2, lines 5-6; claim 3, line 3; claim 4, line 3: "the proprietor of the digital rights" is unclear if it relates to "the proprietor of the unlimited right access" (claim 1, line 4) or "the proprietor of the limited right access (claim 1, line 8);

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- c. In claim 6, lines 3-4; claim 7, lines 3-4; claim 8, line 3: "the proprietor of the digital rights" is unclear if it relates to "the proprietor of the unlimited right access" (claim 5, line 3) or "the proprietor of the limited right access (claim 5, line 7).

Appropriate correction is required.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/539,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are anticipated by the '696 application. The '696 application claims a method of converting

limited digital rights, which is narrower in scope than the instant application, which claims a method of converting unlimited digital rights.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al. (EP 0715247 A1 and Stefik hereinafter).

As to claims 1 and 5, Stefik discloses a system for controlling the distribution and use of digital works using digital tickets, the system having:

storing digital content and an associated unlimited digital right (page 3, lines 53-54), **wherein said unlimited digital right gives a proprietor of the unlimited right access to the content an unlimited number of times** (page 12, lines 38-42);

converting, when receiving an instruction in accordance therewith, said unlimited digital right into at least one limited digital right, wherein said at least one limited digital right gives a proprietor of the limited right access to the content a limited number of times (page 6, lines 40-45).

As to claims 2 and 6, Stefik discloses:

wherein digital content and associated digital rights are stored at a server of a digital content provider and the step of converting said unlimited right is performed at said server (page 3, lines 53-54; page 12, lines 38-42; page 18, lines 2-3), and wherein connection is established with the server, for sending the server instructions to convert said unlimited right and accessing the content, from a device with computing capabilities operated by the proprietor of the digital rights (page 18, lines 27-32).

As to claims 3 and 7, Stefik discloses:

wherein digital content and associated digital rights are stored at a device (i.e. printer repository) with computing capabilities, which device is operated by the proprietor of the digital rights (page 3, lines 53-54; page 4, lines 49-52), and the step of converting said unlimited right is performed at a server of a digital content provider (page 12, lines 38-42; page 18, lines 2-3), and wherein the content is accessed by the device and connection is established with the server for sending the server instructions to convert said unlimited right (page 18, lines 27-32).

As to claims 4 and 8, Stefik discloses:

wherein digital content and associated digital rights are stored at a device with computing capabilities, which device is operated by the proprietor of the digital rights (page 3, lines 53-54; page 4, lines 49-52), and the step of converting said unlimited right is performed at said device (i.e.

requester), **and wherein the content is accessed at the device** (page 12, lines 38-42; page 18, lines 3-4).

Prior Art Made of Record

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Berstis et al. (US Patent 6,282,653 B1) discloses a system and method for royalty collection for use of copyrighted digital materials on the internet.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Su whose telephone number is (571) 270-3835. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Su/
Examiner, Art Unit 2131

/Ayaz R. Sheikh/
Supervisory Patent Examiner, Art Unit 2131